

**REMARKS/ARGUMENTS**

Claims 1-8 and 16-28 are pending in this Application.

Claims 1, 16 and 24 are currently amended.

Claims 1-8 and 16-28 remain pending in the Application after entry of this Amendment. No new matter has been entered.

In the Office Action, claims 1-4, 6, 7, 16-19, 21, 22, and 24-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,706,097 to Schelling et al. (hereinafter “Schelling”), in view of U.S. Patent No. 5,485,554 to Lowitz et al. (hereinafter “Lowitz”).

Claims 5, 20 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schelling, in view of Lowitz, and in further view of U.S. Patent No. 5,857,185 to Yamaura (hereinafter “Yamaura”).

Claims 7 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schelling, in view of Lowitz, and in further view of U.S. Patent No. 6,098,082 to Gibbon et al. (hereinafter “Gibbon”).

**Claim Rejections Under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejections and request reconsideration and withdrawal of the rejections based on Schelling, in view of Lowitz, Yamaura, and Gibbon. The Office Action alleges that the combination of references teach or disclose all of the claimed limitations of the corresponding claims and that one having ordinary skill in that art at the time of the invention would have been motivated to incorporate the teachings of Schelling with the teachings of Lowitz, Yamaura, and Gibbon.

Applicants respectfully submit that in the Office Action, a prima facie case of obviousness in the Office Action has not been established. In order to establish a prima facie showing of obviousness, three requirements must be satisfied: all limitations of a pending claim must be expressly or impliedly disclosed by prior art references; there must be a suggestion or motivation in the art for the ordinarily skilled artisan to combine the limitations; and there must

be a reasonable expectation of success in making such a combination. (M.P.E.P. § 2143). Applicants submit that Schelling, Lowitz, Yamaura, and Gibbon, either individually or in combination, fail to teach or suggest at least one of the claimed limitations recited in each of the corresponding claims.

#### Claim 1

Claim 1 recites a computer-implemented method of generating a coversheet for a multimedia paper document comprising one or more pages. As recited in claim 1, a printable representation of multimedia information is printed on each page of the one or more pages. The multimedia information recited in claim 1 includes video information. As recited in claim 1, for each page in the one or more pages of the multimedia paper document a thumbnail image representing the page is printed on a paper medium to generate the coversheet.

The Office Action rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Schelling in view of Lowitz. Applicants, however, submit that Schelling and Lowitz, either individually or in combination, fail to teach or suggest the above-recited features of claim 1.

Applicants submit that Schelling has nothing to do with generating a coversheet for a multimedia paper document as the method recited in claim 1. The Office Action states that Schelling discloses “generating an index print (coversheet) for multimedia (video, audio, and images) having a plurality of index images representing still images, motion sequences and sound sequences.” (Office Action: Page 2). The Office Action also states that Schelling teaches generating an index print for a multimedia document (video, audio, images) having a plurality of index images. (Office Action: Page 3). The multimedia or multimedia document (e.g., video, audio, and images) of Schelling for which the index print is generated are “digital data files containing images, motion sequences and sound sequences.” (Schelling: Abstract).

Though Schelling discloses generating an index print for the digital data files, the digital data files of Schelling are substantially different from a multimedia paper document as recited in claim 1. Furthermore, the index print of Schelling is substantially different from a

coversheet for a multimedia paper document as recited in claim 1. The method of claim 1 requires 1) a coversheet for 2) a multimedia paper document comprising one or more pages. The method of claim 1 further requires 3) a printable representation of multimedia information printed on each page of the one or more pages of the multimedia paper document. In contrast, Schelling merely discloses a) digital data files storing audio, video, and images and b) an index print for audio, video, and images stored in the digital data files. Schelling does not teach or suggest generating a coversheet for a multimedia paper document as recited in claim 1.

The Office Action further alleges that Schelling teaches that the index print “may be used for printing an image (thumbnail) of the document (page, index page)” in the Abstract; Col. 1, lines 58-67; Col. 2, lines 1-14 and lines 43-67; Col. 4, lines 57-67; and Col. 5, lines 6-12 of Schelling. Applicants submit that Col. 2, lines 1-14 of Schelling merely disclose that the index print is useful for accessing individual images, image sequences, and sound sequences for cataloging, storage, or for ordering prints of still images or copies of the video and sound sequences. Schelling’s index print therefore at best corresponds to the “multimedia paper document” recited in claim 1. The “document” referred to in the Office Action is the digital data files of Schelling discussed above, and not the multimedia paper document as recited in claim 1. Nowhere does Schelling disclose printing an image or thumbnail of the index image of Schelling as alleged in the Office Action to teach or suggest generating a coversheet for a multimedia paper document as recited in claim 1.

Further, Applicants submit that Schelling does not teach or suggest “for each page in the one or more pages of the multimedia paper document printing a thumbnail image representing the page on a paper medium to generate the coversheet” as recited in claim 1. The Office Action correctly notes that Schelling does not teach or suggest “printing a thumbnail image of a page of a multimedia paper document to generate a cover sheet” (emphasis added). (Office Action dated March 21, 2006: Page 4). The same conclusion was reached by the Examiner in the Notice of Allowability dated April 19, 2005, which states the Schelling fails to teach or suggest “generating pages having printable representations of multimedia information and then printing a thumbnail image for each page on the index print.”

In the present Office action, the Examiner cited Lowitz to supply the missing teaching. However, Applicants submit that Lowitz fails to cure the above-identified deficiencies of Schelling. The Office Action relies on Lowitz for its teaching as allegedly disclosing “printing video images on a printable medium for presenting and organizing the video images, which can be printed alone and together with annotations.” Lowitz has nothing to do with generating a coversheet for a multimedia paper document as the method recited in claim 1. As discussed above, the method of claim 1 requires 1) a coversheet for 2) a multimedia paper document comprising one or more pages. The method of claim 1 further requires 3) a printable representation of multimedia information printed on each page of the one or more pages of the multimedia paper document. In contrast, Lowitz merely discloses a) printing video images on b) a printable medium for presenting and organizing the video images. Lowitz does not teach or suggest generating a coversheet for a multimedia paper document as recited in claim 1.

Applicants further submit that Lowitz does not teach or suggest “for each page in the one or more pages of the multimedia paper document printing a thumbnail image representing the page on a paper medium to generate the coversheet” as recited in claim 1. Lowitz teaches printing selected video frames on a paper medium. The printing of frames of a digital video on paper in Lowitz is substantially different from printing a thumbnail representing a page of a multimedia paper document on paper as recited in claim 1.

Therefore, even if Schelling and Lowitz were combined as suggested in the Office Action (although there appears to be no motivation in the references for the combination), the resultant combination would not teach or suggest “printing video images on a printable medium for presenting and organizing the video images, which can be printed alone and together with annotations” as recited in claim 1. Thus, Applicants submit that claim 1 is allowable.

#### Claims 2-8 and 16-28

Applicants submit that independent claims 16 and 24 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others. Applicants submit that dependent claims 2-8, 17-23, and 25-28 that depend directly and/or indirectly from

the independent claims 1, 16, and 24 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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